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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851849	05/09/2001	Bruce R. David	10420/12	3674

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EXAMINER

BRIGGS, WILLIAM R

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,849

Applicant(s)

DAVID ET AL.

Examiner

William Briggs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 1/21/2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, 3,476,161 in view of Woods.

Dunlap teaches a "router apparatus" in the embodiment of figures 8 and 9 wherein a "guide" is attached to a workpiece surface and a "platform" is mounted thereon and a router "having a vertical adjustment" and an endmill cutter therein is provided on the "platform." While the "guide" in Dunlap is not fastened to the workpiece by "fasteners drilled through the skin" one possessing ordinary skill in the related art would be expected to readily adapt known fastening means as taught by Woods wherein fasteners attach a "guide" to a workpiece surface to modify the attachment means of Dunlap as the equivalent stabilization and fixing of the guide is unchanged in the modification and such would achieve the benefits of more rigid attachment of the guide that is inherent in use of fasteners as taught by Woods. Note that design features such as the shape and composition of the guide, particular "three-fluted" end mill used, "grips on the router," and power source for the router, if not already taught in Dunlap, would be obvious to one possessing ordinary skill in the art as design variants that are non-critical and/or within the knowledge of the ordinarily skilled artisan.

Claims 1-11 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, 3,476,161 in view of Woods as applied to claims 12-21 above, and further in view of Stornetta.

Use of a "vacuum fitting" for collecting machining debris is well-known in the machine tool art as taught by Stornetta wherein a router has a vacuum attachment and use of such attachment in the device of Dunlap as modified by Woods would be obvious to one possessing ordinary skill in the art to achieve the benefits that would accrue thereto as set forth in Stornetta such as reduced hazard to the operator.

Response to Arguments

In response to applicant's argument that Dunlap is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the rejection of claims 12-21 in Paper No. 6 based upon Dunlap in view of Woods has clearly been misread by Applicants. Perhaps Applicants are mistakenly making reference in their comments to Dunlap, US 3,456,555, not applied in the rejections. Regardless, Applicants have completely overlooked the section of the previous rejection that specifically denotes the alternate embodiment and sections of the disclosure of Dunlap, US 3,476,161, that deal specifically with a "router" in the embodiment of figures 8 and 9 and not merely the "tool guide support and saw guard" to which Applicants make reference. Thus, Applicant's comments that "Dunlap neither

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suggests nor describes a router or sheet metal router" are incorrect. Quoting from Dunlap at column 5, line 54-55, "the tool is a router 98 having the tool 100 and being vertically, reciprocally supported on the support frame 102" and in column 6, lines 24-25, "the router 98, is mounted reciprocal relative to the workpiece 130 so that the router tool may be engaged into the workpiece surface 128, as shown in figure 9." Thus, the claimed vertical adjustment of a router that is movable along a guide removably attached to a workpiece are explicit in Dunlap, and all of Applicants' comments with regard to the relevance and applicability of Dunlap in the rejection are clearly mistaken.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dunlap teaches that his support plate "may be secured to the workpiece top surface by any usual → c of 4
clamping means, not shown, or by any of the usual adhesives so as to be removable
from the workpiece surface." As a result, the person of ordinary skill in the art is taught that "usual clamping means" suffice to attach the removable guide of Dunlap to a workpiece. Thus one possessing ordinary skill in the art would be expected to choose known "usual clamping means" such as the "fasteners drilled through the skin" or latch

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bolts 36" in Wood that "clamp up" a guide to a workpiece yet allow the removal of the guide as an alternative to the exemplary guide clamping means shown in Dunlap.

Applicant's stated assumption that claims 11 is included in the Paper No. 6 rejection of claims 1-10 and 22-25, as rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap, 3,476,161 in view of Woods as applied to claims 12-21, and further in view of Stornetta, is correct. With regard to the propriety of the rejection, it is noted that the figures 8 and 9 embodiment of Dunlap clearly teaches a router that is vertically adjustable relative to a workpiece surface. It is well-known and common to provide a "vacuum fitting" for a router as taught in Stornetta and the suggestion to combine the references is found in the benefits of enhanced worker safety and reduced environmental hazard that accrue to use of vacuum fittings to contain and collect cutting debris.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to William Briggs who may be reached at (703) 308-1739 during his normal duty hours of 7:30 a.m. to 6:00 p.m., Tuesday through Friday. Messages may be left with the Technology Center 3720 receptionist who may be reached Monday through Friday between the hours of 8:30 a.m. to 5:00 p.m. at (703) 308-1148. In order to reduce pendency and avoid potential delays, Technology Center 3720 is encouraging FAXing of responses to Office Actions directly into the Technology Center 3720 at (703)305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Technology Center 3720 will be promptly forwarded to the examiner.


WILLIAM BRIGGS
PRIMARY PATENT EXAMINER
ART UNIT 3722